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No. 95-45

In the Supreme Court of the United States

OCTOBER TERM, 1995

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.,

Petitioners,

v.

OGONTZ CONTROLS COMPANY and THOMAS M. KENNY,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

THOMAS B. KENWORTHY
Counsel of Record
VICTORIA E. SILBEY
MORGAN, LEWIS & BOCKIUS
2000 One Logan Square
Philadelphia, PA 19103
(215) 963-5000

Attorneys for Petitioners

QUESTIONS PRESENTED

1. Whether the Seventh Amendment requires the issue of claim interpretation to be submitted to the jury when extrinsic evidence presented in a patent infringement action at law raises a dispute as to how patent claim terms would have been understood by one skilled in the pertinent art?

2. Whether the Seventh Amendment permits one jury to interpret patent claims in deciding the question of validity and a different jury to again interpret the claims in deciding the question of infringement when the issue of claim interpretation is critical to both infringement and patent validity?

3. Whether a Court of Appeals panel's summary affirmance of an appeal, so as to avoid application of a rule of law of the Court in banc with which that panel disagrees, denies the appellants their statutorily granted right of appeal?

LIST OF INTERESTED PARTIES

The following parties appeared before the United States Court of Appeals for the Federal Circuit in the proceedings below:

Fred L. Pirkle
Therm-Omega-Tech, Inc.
Ogontz Corporation (formerly
Ogontz Controls Company)
Thomas M. Kenny

Petitioner Therm-Omega-Tech, Inc. has no parent company nor subsidiaries.

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No.

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.,

Petitioners,

v.

OGONTZ CONTROLS COMPANY and THOMAS M. KENNY,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioners Fred L. Pirkle and Therm-Omega-Tech, Inc. respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit ("CAFC") entered in this case on April 6, 1995, the day after entry of the in banc decision of the CAFC in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995).

OPINIONS BELOW

The Court of Appeals disposed of the appeal without opinion. The District Court delivered opinions in connection with its rulings on summary judgment motions. Those opinions are unreported, but are reproduced in the appendix to this petition. The District Court delivered no opinions in connection with its dispositions of post-trial motions.

JURISDICTION

The judgment of the Court of Appeals was entered on April 6, 1995. A timely petition for rehearing with suggestion for rehearing in banc was denied on May 24, 1995, with Senior Circuit Judge Skelton voting to grant rehearing. App. 49a. The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

CONSTITUTIONAL PROVISIONS AND RULES INVOLVED

This case involves the Seventh Amendment to the United States Constitution and the CAFC's Rule of Practice 36. Each of these provisions is set forth in the appendix.

STATEMENT OF THE CASE

Petitioners Fred L. Pirkle and Therm-Omega-Tech, Inc. and respondents Ogontz Corporation and Thomas M. Kenny ("Ogontz") are the only two competitors in the

United States for the manufacture, sale and repair of mechanical railroad freeze protection valves. Until his employment was involuntarily terminated in October 1982, Mr. Pirkle had been employed by Ogontz. Prior to Mr. Pirkle's entry into the market after his termination by Ogontz, Ogontz had enjoyed no competition in the mechanical railroad freeze protection industry.

Mr. Pirkle is the inventor of a mechanical railroad freeze protection valve known as the MV-1, as to which he obtained U.S. Patent No. 4,460,007 ("the '007 patent") in July 1984. Litigation between the parties began when Ogontz brought suit in Pennsylvania state court in September 1983 claiming ownership of the '007 patent pursuant to a contractual provision entitling Ogontz to ownership of inventions made by Mr. Pirkle during his employment. In the fall of 1988, the state court entered a final decree in Ogontz's favor directing Mr. Pirkle to assign the '007 patent to Ogontz and to account for any profits made from sales of MV-1 valves. That decree was affirmed on appeal and Mr. Pirkle fully performed his obligations pursuant thereto.

While the state court proceedings were pending, petitioners initiated two actions in the United States District Court for the Eastern District of Pennsylvania, one in 1986 and one in 1990, which actions were ultimately consolidated in 1992. Petitioners asserted various federal and state law causes of action. Ogontz asserted counterclaims, including claims that petitioners had infringed the '007 patent and U.S. Patent No. 4,878,512 ("the '512 patent").

None of petitioners' claims were permitted to go to the jury. Some were addressed by summary judgment and some were addressed pursuant to Fed. R. Civ. P. 50(a)(1) at the close of all evidence. Accordingly, the only claims that were submitted to the jury were Ogontz's patent infringement claims.

The jury in the first trial was deadlocked on the issue of infringement of the '007 and '512 patents by petitioners' Guru Plugs,[1] but they were able to reach agreement and reject the defenses of patent invalidity and inequitable conduct. The District Court ordered a new trial on the issues of infringement and damages. Petitioners argued that the Seventh Amendment mandated that the new trial also address the issue of patent invalidity since that issue also involved claim interpretation and was therefore inextricably intertwined with the issue of infringement. The District Court denied that motion without opinion. App. 2a.

The second trial covered alleged infringement by petitioners and damages through March 30, 1994. Petitioners made motions for JMOL at the close of Ogontz's evidence and at the close of all evidence. Those motions were not granted. The case (including the issue of claim interpretation) was submitted to the second jury which returned a mixed verdict: no devices were found to infringe either the '512 patent or claims 1-3 of the '007

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[1] "Guru Plug" is the trade name used with respect to a family of mechanical freeze protection plugs first invented by Mr. Pirkle in 1988 and as to which he was granted several patents. There is no claim by Ogontz to ownership of the Guru Plug patents.

patent. Some types of Guru Plugs, however, were found to infringe claims 4, 9 and 10 of the '007 patent, and lost profits were awarded.[2]

At no time did the District Court instruct either of the juries as to what the proper interpretation of the claim language in issue was.[3] In renewing their motion for JMOL after the verdict of the second jury, petitioners asked the District Court to interpret certain terms in issue as a matter of law, relying on existing CAFC precedent that "[c]laim interpretation is a question of law for the court. * * * Where the court's interpretation is not set forth in its instructions to the jury, the court must perform its role of deciding this issue of law in ruling on the JNOV motion." *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-23 (Fed. Cir. 1992). The District Court did not interpret any of these claim terms and denied petitioners' post-trial motions without opinion. App. 19a.

On appeal to the CAFC, petitioners asserted a number of errors, including challenges to the grants of summary judgment and JMOL on petitioners' claims. Petitioners also attacked the judgment of infringement on several grounds. Petitioners first argued that because claim interpretation was a critical element in the determination

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[2] Claims 4, 9 and 10 of the '007 patent are quoted verbatim in the District Court's Final Injunction. App. 6a - 13a.

[3] Since the issue of claim interpretation was to be decided by the jury, petitioners had requested the District Court to submit specific claim interpretation interrogatories to the jury. That request was denied.

of both infringement and the invalidity defenses of anticipation and obviousness, and because the claims of a patent must be given the same interpretation when considering infringement as when considering validity, *Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989), the Seventh Amendment compels a new trial where the issue of claim interpretation is given to different juries in resolving separate aspects of the same case. *See Witco Chemical Corp. v. Peachtree, Doors, Inc.*, 787 F.2d 1545 (Fed. Cir.), *cert. dismissed*, 479 U.S. 877 (1986). [Brief for Appellants, pp. 29-30; Reply Brief, pp. 15-17].

Petitioners also argued, again citing *Read*, that the claims should be interpreted by the CAFC, and that when the claims are properly interpreted, the evidence would not support the infringement verdicts.[4] [Brief for Appellants, pp. 32-45; Reply Brief, pp. 20-25]. Additionally, petitioners argued that having submitted the issue of claim interpretation to the jury and having charged the jury that in interpreting the claims they "should consider . . . dictionary definitions . . . . ", the District Court's refusal to take judicial notice and permit the reading of specific dictionary definitions of a number of pertinent terms found in Claims 4, 9 and 10 of the '007 patent prejudiced their substantial rights and required a

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[4] Petitioners also made arguments regarding the impropriety of recovering damages for the manufacture and sale of valves that predated the assignment of the '007 patent to Ogontz, and the non-recoverability of lost profits under the facts of this case.

new trial. [Brief for Appellants, pp. 30-32; Reply Brief, pp. 18-20].

Oral argument in this case was presented on April 5, 1995 to a panel of the CAFC comprised of Circuit Judges Newman and Rader and Senior Circuit Judge Skelton. At the commencement of oral argument, petitioners' counsel acknowledged his awareness that issues regarding the respective roles of judge and jury in connection with claim interpretation were pending before the Court in banc in *Markman v. Westview Instruments, Inc.*, CAFC No. 92-1049, and expressed an intent not to orally argue those issues to the panel because when handed down, the *Markman* in banc decision would control. Petitioners' counsel was unaware, and the panel did not disclose, that the opinions in *Markman*, including opinions by panel Judges Newman and Rader, were being released that very day. Those opinions are now published at 52 F.3d 967 (Fed. Cir. 1995).

In *Markman*, an eight judge majority ruled that "in a case tried to a jury, the court has the power and the obligation to construe as a matter of law the meaning of the language used in the patent claim," 52 F.3d at 979, and a failure to instruct the jury as to the meaning of the claims cannot be harmless when the district court does not thereafter construe the claims in the course of granting judgment as a matter of law. *Id.* at 981-82. In a concurring opinion, in the case of Judge Mayer, *id.* at 989-98, and a dissenting opinion, in the case of Judge Newman, *id.* at 999-1026, it was argued forcefully that where the evidence presents a disputed issue of fact as to

what claim terms would have meant to one skilled in the pertinent art at the time of the invention, the Seventh Amendment requires that the issue of claim interpretation be submitted to the jury.

The day after the oral argument in this case and the release of the opinions in *Markman*, the Clerk entered a judgment without opinion in this case (App. 1a):

> AFFIRMED. *See* Fed. Cir. R. 36.

Literature from the CAFC received with the judgment stated that "a judgment of affirmance without opinion under Fed. Cir. R. 36 . . . is used only when the appellant has utterly failed to raise any issues in the appeal that require an opinion to be written in support of the Court's judgment of affirmance." None of the issues presented to the CAFC were appropriate for Rule 36 disposition without opinion. Indeed, since an affirmance of the District Court's orders could not be reconciled with the previous day's holding of the in banc majority in *Markman*, the Clerk's entry of judgment of affirmance without opinion appeared to have been a clerical mistake.

A petition for rehearing with suggestion for rehearing in banc was filed. Although Senior Judge Skelton (who had not participated in *Markman*) voted to rehear the case, Judge Newman and Rader, neither of whom had agreed with the *Markman* majority, did not vote to rehear the case and the petition was denied.

REASONS FOR GRANTING THE PETITION

I. Whether The Seventh Amendment Requires That The Meaning Of Patent Claim Terms Be Submitted To The Jury, When Extrinsic Evidence Raises A Genuine Dispute, Is An Issue Of Exceptional National Importance

This Court has been asked to review no patent-related issue of greater national importance or pervasive effect than the issue presented by this case concerning the command of the Seventh Amendment regarding the proper roles of judge and jury vis-à-vis patent claim interpretation.[5] The intrinsic importance of the first issue presented by this petition is manifest from the divergent opinions of a sharply divided CAFC in *Markman*. The importance placed on the issue by the intellectual property community is evident from the participation of nine amici curiae (who filed seven separate briefs totalling 131 pages) before the CAFC in *Markman*. The *Markman* decision is in all regards properly characterized as both a "controversial decision" and a "landmark ruling." *See* 81 A.B.A.J. 24 (July 1995).

The importance attaching to the issue is hardly surprising. Claim interpretation is the first step to be addressed when deciding patent infringement. This is a vitally important step and must not be given "short shrift."

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[5] Related petitions for writs of certiorari are pending in *Markman v. Westview Instruments, Inc.*, No. 95-_____ (filed July 3, 1995) and *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081 (filed June 20, 1995).

Lemelson v. General Mills, Inc., 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993). Indeed, as Judge Newman observed in her dissenting opinion in *Markman*, "[d]eciding the meaning of the words used in the patent is often dispositive of the question of infringement." 52 F.3d at 999. Claim interpretation is also integral to analyses of the validity defenses of anticipation and obviousness. *Lemelson*, 968 F.2d at 1206.

Not only is the issue of claim interpretation preeminent in patent cases, but the Seventh Amendment is implicated in most cases since the majority are tried to juries.[6] As this Court reiterated in *Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990):

> "'Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care'". . . .

The *Markman* majority having recognized that there is a right to a jury trial in a patent infringement action at law, 52 F.3d at 984, and that "[e]xtrinsic evidence . . . may be necessary to inform the court about the language in which the patent is written," *id.* at 986, the logic of the CAFC's curtailment of the right to have the jury resolve disputes raised by such extrinsic evidence is not evident. It would

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[6] In fiscal year 1994, 70% of patent trials were tried to juries. 1994 Preliminary Annual Report of the Director of Administrative Office of the United States Courts, Table C-4 (available from the Administrative Office's Statistics Division).

not appear to be of constitutional significance that "[i]t is not ambiguity in the document that creates the need for extrinsic evidence but rather unfamiliarity of the court with the terminology of the art to which the patent is addressed." *See id.*

The function of weighing and assessing the credibility of a witness' testimony "belongs to the jury, who are presumed to be fitted for it by their natural intelligence and their practical knowledge of men and the ways of men; and so long as we have jury trials they should not be disturbed in their possession of it, except in a case of manifest and extreme abuse of their function." *Sartor v. Arkansas Natural Gas Corp.*, 321 U.S. 620, 628 (1944) (quoting *Aetna Life Ins. Co. v. Ward*, 140 U.S. 76, 88 (1891)). If the jury's role in adjudging the credibility of witnesses and weighing competing evidence regarding claim interpretation is to be curtailed, it should only be done after the issue has been "scrutinized with the utmost care" by this Court.

II. The Present CAFC Position That Claim Interpretation Is In All Cases A Question Of Law Exclusively For The Court Is In Conflict With The Prior Teachings Of This Court Regarding Cases In Which Extrinsic Evidence On The Issue Has Been Presented

In holding that claim interpretation is a question of law exclusively for the court, even when extrinsic evidence has been received as to how disputed claim terms would have been understood by a person skilled in the pertinent art, the CAFC has departed from the prior teachings of this

Court. This conflict alone provides a compelling reason for the grant of a writ.

Three of this Court's opinions that address the subject: *Singer Co. v. Cramer*, 192 U.S. 265 (1904), *Market Street Cable Railway Co. v. Rowley*, 155 U.S. 621 (1895), and *Heald v. Rice*, 104 U.S. 737 (1882), were not even discussed by the *Markman* majority.[7] Two other cases: *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870) and *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), were addressed, but not meaningfully distinguished. *See* 52 F.3d at 987-88.

The *Markman* majority cited *Silsby* in support of the proposition that the jury should have no involvement in determining the meaning of patent claim terms. 52 F.3d at 977. The Court in *Silsby* did, in fact, state that "[t]he construction of the claim was undoubtedly for the court." 55 U.S. at 225. "Construction," however, properly refers to the "legal effect" of a claim, whereas "interpretation" relates to the "meaning" thereof. *Markman*, 52 F.3d at 1000-01 (Newman, J., dissenting). It is clear that the Court in *Silsby* appreciated this distinction. Indeed, the claimed error in *Silsby* was that the trial court improperly left to the jury the question of what the claimed invention was. 55 U.S. at 225 ("The objection made to it is, that the court left to the jury what was a matter of law."). In rejecting the argument that the trial judge should have defined the claimed invention, the *Silsby* Court aptly

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[7] The *Markman* majority relegated these cases to a string cite. 52 F.3d at 977.

stated: "How could the Judge know this as a matter of law?" *Id.* at 226. The *Silsby* Court went on to hold that the determination of what the claimed invention was "became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both . . . . " *Id.*[8]

In *Bischoff*, this Court noted that "the specifications for patents are documents of a peculiar kind" and that the claimed inventions "are commonly described by terms of art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand them . . . . " 76 U.S. at 815. Characterizing the issue as "an important question of practice under the patent law," *id.* at 814, this Court held that the determination of the character of the thing invented, from the patent specification and evidence *in pais*, was a question for the jury. *Id.* at 815-16.

From *Silsby*, *Bischoff* and other precedents of this Court, it can be discerned that the factor determining the jury's role in ascertaining the meaning of patent language is whether or not extrinsic evidence has been presented. *See Market Street Cable Railway Co.*, 155 U.S. at 625 ("No extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject-matter

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[8] The fact that the type of claim involved in *Silsby* is no longer statutorily permissible is of no legal significance to the question of whether interpreting the meaning of the claim as drafted is a question for the jury when extrinsic evidence has been presented. The *Markman* majority's attempt to distinguish *Silsby*, 52 F.3d at 987-88, is not persuasive.

. . . . The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury."); *Heald*, 104 U.S. at 749 (same); *Singer*, 192 U.S. at 275 (same). If the rule of law established by the CAFC in *Markman* the day before judgment was entered in this case is to be endorsed by this Court, the foregoing cases must be overruled.

III. The Seventh Amendment Issues Are Squarely Presented By This Case

In *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), this Court very clearly stated that "the scope and content of the prior art" and "the level of ordinary skill in the pertinent art" are "basic factual inquiries."[9] At the trials of this case, petitioners presented prior art pertinent to the meaning of disputed claim terms, together with testimony of both the inventor and Ogontz's own Chief Engineer at the time of the invention, as to what these terms would have meant to those skilled in the pertinent art. Petitioners are mindful of the observations of Professor Blume:

> The right guaranteed by the Constitution is the right to jury *trial*; not a right to a jury's *verdict*.

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[9] It is not debated that patent claims must be interpreted as they would have been understood by "one of ordinary skill in the art at the time of the invention." *Markman*, 52 F.3d at 986. The CAFC has observed that "'a person having ordinary skill in the art,' [is] not unlike the 'reasonable man' and other ghosts in the law." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987).

> There is no right to a trial unless there is an issue to be tried.
>
> In applying what may be called the "issue" test to determine whether there is a right to jury trial, each factual element in the claim or defense should be considered separately. There may be issues formed by the evidence as to some of the facts and not as to others. Only those facts which are in issue under the evidence should go to the jury for determination.
>
> The right of jury trial extends to these facts, and to these alone.

W. Blume, *Origin and Development of the Directed Verdict*, 48 Mich. L. Rev. 555, 574 (1950). Neither Ogontz nor either of the courts below, however, have ever suggested that petitioners did not present extrinsic evidence supportive of their urged interpretations of the disputed claim terms.[10]

The Seventh Amendment issue is implicated in this case somewhat differently from the manner in which it was raised in *Markman*. In this case the District Court did not usurp the jury's claim interpretation role. Rather, the Seventh Amendment error relates to the "no reexamination of facts" clause as applied in the context of a partial new trial. *See Gasoline Products Co., Inc. v. Champlin Refining Co.*, 283 U.S. 494 (1931).

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[10] The District Court judgment against petitioners cannot be sustained in the manner urged by Judge Rader in *Markman*. 52 F.3d at 998-99.

In a jury case involving disputes as to both infringement and invalidity (anticipation and obviousness), the common question of claim interpretation critical to both issues precludes the trial of infringement and validity to separate juries. *See Witco v. Chemical Corp. v. Peachtree Doors, Inc.*, 787 F.2d 1545 (Fed. Cir.), *cert. denied*, 479 U.S. 877 (1986). The issue is pointedly framed in this case where the unrefuted evidence of record is that Claims 4 and 10 of the '007 patent can not properly be construed to be both valid *and* infringed by Guru Plugs.

The posture of this case is such that the important Seventh Amendment issues presented must be reached in reviewing the judgments below. There is no nonconstitutional ground upon which the judgments below can be upheld.[11] Certiorari should be granted in this case and in the *Markman* case, No. 95-_____, and the cases should be heard in tandem.

IV. The Seventh Amendment Issues Presented In This Case And In *Markman* Have Fully Matured And Are Ripe For This Court's Consideration

All appeals in patent cases are taken to the CAFC. *See* 28 U.S.C. §1295(a)(1). That Court in banc has addressed the role of juries in deciding claim interpretation, and its

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[11] The judgments are unsustainable no matter which way the central Seventh Amendment issue is decided. If claim interpretation is held to be a jury question, the partial new trial on infringement only was inconsistent with *Gasoline Products* and *Witco*. If claim interpretation is a matter of law exclusively for the court, the District Court's failure to interpret the claims for the juries compels a new trial.

divergent views have been fully explicated. Accordingly, further debate on the issue in the CAFC and the lower courts has been foreclosed. Absent grant of review by this Court now, it is unlikely that the issue will be preserved for review in cases tried after the CAFC's *Markman* decision. The Seventh Amendment issues presented in this case have fully matured and are ripe for consideration by this Court. There is no reason for this Court to refrain from definitively resolving the issues now.

V. The CAFC's Excessive And Improper Utilization Of Federal Circuit Rule 36 Constitutes Such A Marked Departure From An Acceptable Course Of Appellate Judicial Procedure As To Call For The Exercise Of This Court's Supervisory Power

The CAFC's utilization of the practice of deciding appeals on the merits without opinion is of relatively recent origin. Upon its establishment in 1982, the CAFC initially adopted a rule that provided for an opinion in all cases:

> **Federal Circuit Rule 18 [1982]** . . . . Disposition of appeals shall be with a published opinion or an unpublished opinion. Opinions which do not add significantly or usefully to the body of law or would not have precedential value will not be published in commercial reports of decisions.

As former Chief Judge Markey noted at the First Annual Judicial Conference of the CAFC:

> [T]he Court agreed at the outset to issue an opinion in every single case decided on the

> merits. Some would be published, and some would not be, but every case would get an opinion and every opinion would tell the loser why he lost.

100 F.R.D. 499, 509 (1983). This policy of sound appellate court practice was consistent with the views expressed on the subject of appellate opinions by the Advisory Council on Appellate Justice of the Federal Judicial Center in FJC Research Series No. 73-2, *Standards For Publication Of Judicial Opinions* (1973):

> One purpose of a judicial opinion is to permit the parties and their attorneys to see that the judges have considered their positions and arguments and to see the reasoning on which the court reached its conclusion. * * *
>
> Still another basis for requiring a written statement of reasons in connection with the disposition of cases relates to the process of deciding cases. Most people find that their thinking is disciplined by the process of written expression. The reduction of ideas to paper, the organization of ideas on paper, significantly affects ultimate decisions; fuzzy thinking is exposed and in the collegial setting of an appellate court, errors are corrected. * * *
>
> . . . We believe that the recommendations in this report promote economy of effort while accommodating the principle that all appellate decisions should be in writing.

The CAFC's original opinion writing practice was also consistent with the recommendations of the Commission

on Revision of the Federal Court Appellate System that "in every case there be some record, however brief, and whatever the form, of the reasoning which impelled the decision." June 1975 Commission Report published at 67 F.R.D. 195, 258 (1975). In the Commission's view, "decision without any explanation . . . provides the litigants and their counsel with less than they are due." *Id.* at 257. Similarly, at the Fourth Annual Judicial Conference of the CAFC, Professor Robert G. Vaughn observed that one of the important values at stake "is the right of a litigant to have some explanation of why the court has decided their case in a particular way. [T]his not only goes to the efficiency of the court but alternately it goes to the authority of the court -- the legitimacy of the acceptance of decisions of the court." 112 F.R.D. 439, 463 (1986).

Fed. Cir. R. 36, App. 51a, which permits summary affirmance without opinion, was adopted in 1989. Former Chief Judge Markey suggested that the rule would be appropriate for use when the criteria are met and there has been an opinion in the district court addressing each of the issues raised on appeal such that "the recipient reads again, if he has to, the affirmed decision below to find out why he lost an appeal." Eighth Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit, 133 F.R.D. 245, 254 (1990).[12]

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[12] There were no District Court opinions in this case regarding the Seventh Amendment or patent-related issues urged on appeal.

The practice of appellate decision without opinion "has been uniformly condemned by commentators, lawyers, and judges." William L. Reynolds & William M. Richman, *The Non-Precedential Precedent -- Limited Publication and No-Citation Rules in the United States Courts of Appeals*, 78 Colum. L. Rev. 1167, 1174 (1978) (footnotes omitted). In a panel discussion at the Ninth Annual Judicial Conference of the CAFC, Judge Avern Cohn of the United States District Court for the Eastern District of Michigan pointedly made the following inquiry of a CAFC judge and fellow panelist:

> [I]f you're going to require us to be rational and explain and justify, why do you reserve to yourself the privilege of simply saying, "Affirmed," for one of five reasons which you don't differentiate when you say "affirmed."

140 F.R.D. 57, 71 (1991). Judge Cohn also expressed the views shared by petitioners and most recipients of Fed. Cir. R. 36 orders: "if I were the litigant I would be very offended at the American legal system that did not give me some explanation." *Id.* at 73.

The circumstances presented in this case and the co-pending case of *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081, are unfortunately not isolated aberrations. The lawyers' comments about the CAFC, as found in Volume 2 of the Almanac of the Federal Judiciary (Aspen Law & Business 1995) at p. 2, suggest a widespread problem:

> Another problem that attorneys brought up repeatedly was the overuse of Rule 36 . . . .
>
> Nearly all lawyers interviewed believed the court was using it to duck important issues. * * * "Rule 36 is being used too much. When Rule 36 was initiated it was used in 10 percent of the cases before the court. Now, it is used in 40 percent of the cases." "When they declined to issue an opinion in what I thought was a precedent setting case, it left me cold. I think that they want to dodge controversial cases."

Dissatisfaction with abuses in the summary disposition of appeals without opinion has not been limited to scholarly discussion in law reviews, at judicial conferences and in surveys of CAFC practitioners. Indeed, Fed. Cir. R. 36 has been the specific subject of at least four other petitions for writs of certiorari. *See Astronics Corp. v. Patecell*, No. 92-396, 61 U.S.L.W. 3268, *cert. denied*, 113 S. Ct. 442 (1992); *Intermedics, Inc. v. Ventritex Co., Inc.*, No. 94-222, 63 U.S.L.W. 3190, *cert. denied*, 115 S. Ct. 205 (1994); *CPC International, Inc. v. Archer Daniels Midland Co.*, No. 94-1099, 63 U.S.L.W. 3579, *cert. denied*, 115 S. Ct. 1176 (1995); *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081 (filed June 20, 1995). Although the three petitions that have been addressed by the Court set forth cogent reasons as to why Fed. Cir. R. 36 was being abused, and drew amicus support from the District of Columbia Chapter of the Federal Bar Association, The Bar Association of the District of Columbia and the Federal Circuit Bar Association, none of those cases

presented a separate issue of substantive law warranting review by the Court.

One might have hoped that the fact that litigants had sought Supreme Court review regarding Fed. Cir. R. 36 would have tempered its use by the CAFC. Review having been denied, however, the use of Fed. Cir. R. 36 has steadily increased to the extent that in the first six months of 1994, the CAFC affirmed without opinion 44% of all appeals from district courts. *See* Brief for Amicus Curiae Federal Circuit Bar Association, *CPC International, Inc. v. Archer Daniels Midland Co.*, No. 94-1099, reproduced at 4 Fed. Cir. Bar J. 269, 294 (1994).

In this case and the *U.S. Surgical* case, the panels' use of Fed. Cir. R. 36 to avoid application of the *Markman* decision deprived the appellants not only of the benefit of the *Markman* holding, but also of meaningful appellate review of the other issues presented.[13] Moreover, both of these cases present for review extraordinarily important issues regarding the respective roles of judge and jury in connection with patent claim interpretation.

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[13]Petitioners do not ask this Court to decide the merit of the other issues which they presented to the CAFC. Rather, as to those issues, petitioners request a remand with directions that they be reconsidered and decided upon principled analysis. If the Court is not inclined to grant review on the Seventh Amendment issues, it should nevertheless grant the petition, vacate the judgment of the CAFC, and remand the case with instructions to apply the *Markman* holding and address in a principled manner the other issues presented.

In addition to granting review of the Seventh Amendment issues surrounding claim interpretation, the Court should exercise its supervisory jurisdiction to rectify the CAFC's departure from an acceptable course of appellate judicial procedure, and provide guidance as to when, if ever, an appeal from a district court decision can be decided on the merits without opinion. Allowing the abusive practice of summary affirmances without opinion to continue unchecked can only tarnish public confidence in the judicial system and facilitate a diminution in judicial responsibility and accountability.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

THOMAS B. KENWORTHY
Counsel of Record
VICTORIA E. SILBEY
MORGAN, LEWIS & BOCKIUS
2000 One Logan Square
Philadelphia, PA 19103
(215) 963-5000

Attorneys for Petitioners
Fred L. Pirkle and
Therm-Omega-Tech, Inc.